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In re Application of
MOLEV-SHTEIMAN
Serial No.: 09/529,163
PCT No.: PCT/US98/19708
Int. Filing Date: 18 September 1998
Priority Date: 09 October 1997
Attorney Docket No.: 968/32
For: METHOD OF EMULATING A
SHIFT REGISTER USING A RAM

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: DECISION ON PETITION
:
: TO WITHDRAW HOLDING
:
: OF ABANDONMENT
:

This decision is in response to applicant's "Petition to Withdraw Holding of Abandonment", filed 09 February 2001 in the above-captioned application, requesting, in effect that the application be revived because the Notification of Missing requirements was never received. Given the nature of the relief requested and the evidence submitted, the petition is more appropriately being treated as a petition to withdraw holding of abandonment under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 17 May 2000, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration and the appropriate surcharge for filing the oath or declaration after the thirty month period was required.

On 23 January 2001, a Notification of Abandonment was mailed to applicant indicating that applicant had failed to respond to the 17 May 2000 Notification of Missing Requirements.

On 09 February 2001, applicant filed the instant "Petition to Withdraw Holding of Abandonment" seeking withdrawal of the holding of abandonment and alleging that the Notification of Missing Requirements mailed 17 May 2000 was never received, that no response was made and the application went abandoned. The petition is treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

DISCUSSION

A proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement).

Applicant has neither satisfied Items (1), (2) or (3). Attorney for applicant, Mark Friedman, indicates in the petition that attorney Anthony J. Castorina receives all correspondence addressed to him from the USPTO. Mr. Castorina attests that he "routinely docket[s] in a log all USPTO actions that are addressed to him [Mr. Friedman] that require some further action on his part" and then forwards the mail to Mr. Friedman. Mr. Castorina submitted a copy of a log showing correspondence received from the United States Patent and Trademark Office as it was received (May 1-31, June 1-16, 2000). Mr. Castorina's log, however, does not indicate any correspondence with a response due date of 17 June 2000.

Mr. Friedman's attestation that he routinely records the actions received from Mr. Castorina and that "No entry of docketing a Notice of Missing Requirements or any other USPTO action appears thereon. This indicates that I never received a Notice of Missing Requirements or any other action on the above identified application" is not sufficient proof of nonreceipt. Counsel must conduct a search of the file jacket and docket records, that is, the record where the nonreceived Office action would have been entered had it been received and docketed, and provide a statement stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. What is required is a copy of the docket record showing all responses docketed for the date a response was due (17 June 2000 in this case) showing that there was no record of a response for the present application being due on that date.

Likewise from Mr. Castorina, what is required is a copy of his docket record showing all responses docketed for the date a response was due (17 June 2000 in this case) showing that there was no record of a response for the present application being due on that date. This docket record must be attached to and referenced in practitioner's statement. Applicant has not provided the proper showing necessary to withdraw the holding of abandonment and thus, the petition may not be properly granted.

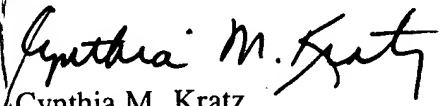
CONCLUSION

The Notification of Abandonment mailed on 23 January 2001 remains in effect.

Applicant's request to withdraw holding of abandonment is **DISMISSED WITHOUT PREJUDICE**.

Applicant has TWO (2) months to file a response. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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